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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,449	03/20/2000	Hideki Hirata	0083-1131-0	6033

22850 7590 01/22/2003

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 01/22/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-15

Office Action Summary

Application No.

09/531,449

Applicant(s)

HIRATA, HIDEKI

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-13 and 18-21 is/are rejected.
- 7) ☒ Claim(s) 14-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed November 6, 2002.
Claim 7 was canceled rendering claims 7-21 pending.

Claim Rejections - 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7, 9-12, 18-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshiaki et al. JP 10269624 A in view of Watanabe et al (U.S. 6,219,308).
4. Yoshiaki discloses a light transmission layer formed on a information recording layer on a main surface of a transparent substrate after dispersing spacer pressurized particles made of resin, where the light transmission layer is of a uniform thickness (abstract) where the pressurized particles are bonding materials adhering the light transmission layer to the substrate. Although Yoshiaki does not explicitly disclose the thickness, it would have been obvious to one of ordinary skill in the art to optimize the light transmission layer because discovering optimum or workable ranges involves only

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routine skill in the art. Yoshiaki does not disclose a light transmitting sheet consisting of polycarbonate.

Watanabe teaches an optical information medium comprising a substrate, a recording layer and a light transmitting layer thickness (abstract) where the light transmitting layer is made of polycarbonate and the substrate has a thickness of 1.2mm (column 1, lines 64-67).

Watanabe teaches the light transmitting adhesive layer comprises a resin (column 12, lines

29-31). Yoshiaki and Watanabe are analogous art because they are from the same field of information recording media. It would have been obvious to include the polycarbonate, adhesive and resinous materials in the light transmission layer of Yoshiaki because Watanabe teaches that the polycarbonate, adhesive and resin materials sustain the integrity and durability of the light transmitting layer. The claimed casting method referred to is a product by process step. The process adds no positive limitation to the claim. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 227 USPQ 964, 966. Although neither reference explicitly teaches pressure sensitive adhesive, Watanabe teaches an adhesive which constitutes

pressure sensitive adhesives. The use of pressure sensitive adhesives in optical information mediums is not new and the average artisan would readily use Watanabe's adhesive in the form of a pressure sensitive adhesive to achieve Applicant's invention. Although Watanabe does not explicitly disclose the adhesive thickness, it would have been obvious to one of ordinary skill in the art to optimize the light transmission layer because discovering optimum or workable ranges involves only routine skill in the art. The adhesive thickness is result effective on the transmittance of the information medium and is therefore optimizable.

Claim Rejections - 35 USC § 103(a)

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshiaki et al. JP 10269624 A in view of Watanabe et al (U.S. 6,219,308) further in view of Ueno et al. (U.S. 5,254,382).
6. Yoshiaki in view of Watanabe are relied upon for claims 7, 9-12, 18-19 and 21. Yoshiaki does not disclose an adhesive layer comprising a transparent acrylic resin. Ueno teaches an optical information medium comprising a protective plate formed by adhering the acrylic resin with an acrylic resin adhesive (column 5, lines 8-10) where the protective plate serves the same function and capabilities of a light transmitting layer. All the references are analogous art because they are from the same field of information media. It would have been obvious to one of ordinary skill in the art to include the acrylic

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resin in the light transmitting adhesive layer of Watanabe because Ueno teaches the resinous material helps sustain the optical clarity of the light transmitting layer.

Claim Rejections - 35 USC § 103(a)

7. Claims 7, 13, 18-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshiaki et al. JP 10269624 A in view of Hirai (U.S. 5,776,643).

8. Yoshiaki discloses a light transmission layer formed on a information recording layer on a main surface of a transparent substrate after dispersing spacer pressurized particles made of resin, where the light transmission layer is of a uniform thickness (abstract) where the pressurized particles are bonding materials adhering the light transmission layer to the substrate. Although Yoshiaki does not explicitly disclose the thickness, it would have been obvious to one of ordinary skill in the art to optimize the light transmission layer because discovering optimum or workable ranges involves only routine skill in the art.

Hirai teaches a light transmitting substrate comprised of polycarbonate or polyarylate having a thickness of .01 to 10mm (column 4, lines 41-55).

Yoshiaki and Hirai are analogous art because they are from the same field of light transmitting material. It would have been obvious to include the polycarbonate or polyarylate in the light transmission layer of Yoshiaki because Hirai teaches that the polycarbonate or polyarylate materials increase the optical clarity of the transmitting layer.

Claim Rejections - 35 USC § 103(a)

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being obvious over Yoshiaki et al. JP 10269624 A in view of Watanabe et al (U.S. 6,219,308) further in view of Tamura et al. (U.S. 5,328,816).

10. Yoshiaki is relied upon for claims 7, 9-12, 18-19 and 21. Yoshiaki does not disclose the light transmitting layer being cut off by laser processing. Tamura teaches a process for producing an information recording medium comprising a substrate with a recording and protective layer formed by cutting the resulting substrate sheet into information recording mediums (abstract) resulting in excess material, such as the protective layer (light-transmitting sheet) cut off that is not adhered to the substrate. Tamura teaches cutting carried out by laser cutting to obtain the information mediums (column 4, lines 54-56). Yoshiaki and Tamura are analogous art because they are from the same field of information media. It would have been obvious to cut the excess light transmitting sheet of Yoshiaki because Tamura teaches that this process is known in the art in order to obtain the final product for consumer use.

11. Claims 14-17 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. The arguments in regards to rejection under 35 USC 103(a) as being unpatentable over Yoshiaki et al. JP 10269624 A in view of Watanabe et al (U.S. 6,219,308) have been considered but are unpersuasive. Applicant argues neither reference discloses a pressure sensitive adhesive. This is not true because Yoshiaki discloses dispersed spacer pressurized particles made of resin, (abstract) where the pressurized particles are bonding materials. Applicant further argues Watanabe does not disclose the pressure sensitive adhesive so no prima facie case of obviousness is made by the combination. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant shows in Table 1 of the Specification superior results when compared to an adhesive layer which is photo-curable. This point is well taken; however, Yoshiaki in view of Watanabe does disclose a pressure sensitive adhesive, therefore, meeting the claim limitations set forth in Applicant's claimed invention. Additionally, although Applicant points out comparisons within Table 1 of the Specification, these comparisons are not reflective of the cited art presented in the rejections. Applicant must show the references instantly cited cannot exhibit the claimed features in order to overcome the

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rejection. Applicant argues no reference has been cited supporting the ascertainment that 'the use of pressure sensitive adhesive in optical information mediums is not new.' The present art supports this by way of Yoshiaki disclosing dispersed spacer pressurized particles made of resin, (abstract) where the pressurized particles are bonding materials.

Applicant persists that no pressure sensitive adhesive is disclosed by Ueno et al, not making obvious the claimed invention. Once again one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues as to rejection 3, Hirai is relied upon but lacks a pressure sensitive adhesive. Applicant fails to corporately view the cited art as a combination. In response to applicant's argument that Hirai and Tamura et al. are relied upon but lacks a pressure sensitive adhesive, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM - 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA M. KELLY
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